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Paper No. 23

In re Application of
Bryan Bergeron
Application No. 09/992,328
Filed: November 19, 2001
Attorney Docket No. 7436-1

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: DECISION ON PETITION
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This is a decision on the petition filed on January 16, 2004 by which petitioner requests withdrawal of the examiner's holding dated January 5, 2004 that the appeal brief filed on October 20, 2003 fails to comply with 37 CFR 1.192(c) because it presents issues which, in the examiner's opinion, are petitionable, holds that the statement of claim status does not comply with 37 CFR 1.192(c)(3), and holds that the claim groupings in the appeal brief do not comply with 37 CFR 1.192(c)(7). The petition is considered pursuant to 37 CFR 1.181, and no fee is required. A refund of the \$130.00 petition fee will be credited to Deposit Account 50-2346.

The petition is granted-in-part. However, petitioner is requested to give careful consideration to the basis for granting the requested relief and to the specific statement of exactly what relief is being granted that appears below.

The Question of Petitionable Matters Appearing in the Appeal Brief

The examiner held that petitioner's appeal contained issues that were proper for decision on petition, (and presumably also contained arguments directed to those issues). 37 CFR 1.192(c) sets forth the requirements pertaining to the items that the appeal brief must include. Nowhere in 37 CFR 1.192(c) is it stated that an appeal brief may not contain specific items, even if such items include issues and arguments that the Board of Patent Appeals and Interferences ("BPAI") will not entertain because they are petitionable pursuant to 37 CFR 1.181, and not appealable pursuant to 37 CFR 1.191. Thus, leaving aside the concept that an Office action may contain both objections that one would ordinarily believe to be petitionable and rejections that are appealable, and that such objections and rejections may sometimes implicate identical issues, thereby necessitating that the resolution of those issues is properly left to the BPAI once an appeal has been filed and perfected (see 37 CFR 1.191 which permits appeal from the final or second or subsequent rejection of claims and compare 37 CFR 1.181 which states that matters that are appealable cannot be petitioned), it is clear that the examiner's holding as embodied item number 9 of the letter dated January 5, 2004 is erroneous.

With respect to the alleged petitionable matters, the record is clarified to specifically indicate that the arguments beginning in the last paragraph of page 2 of the petition, which arguments implicate issues 1, 2 and 3 in petitioner's appeal brief filed on October 20, 2003, were most emphatically not "resolved in applicant's favor by the Decision on Petition dated November 18, 2003 ("Decision") which ordered that the drawings be entered and that withdrawn claims be restored for consideration." That Decision held that certain withdrawn claims be restored for examination on the merits because they were improperly "restricted out" under election of species practice, when in fact the application did not disclose and claim plural species. Obviously, that holding had nothing to do with petitioner's drawings. Further, the Decision directed the entry of formal drawings but did not indicate whether those drawings, or the originally filed drawings, complied with 37 CFR 1.83, i.e. whether any claims recited structure that petitioner had not illustrated in the drawings (issues 1 and in the appeal brief). Nor did the Decision directing entry of the formal drawings reach the issue of whether claims 3 and 8-10 satisfy the statutory requirements for enablement and definiteness, as argued with respect to issue 3 in the appeal brief. Entry of the formal drawings was directed because they did not illustrate anything not present in the original application. This has nothing to do with whether the language in the original application enables the invention or is either an apt description of the invention or a definite description of the invention.

Claim Status (37 CFR 1.192(c)(3))

37 CFR 1.192(c)(3) requires that the brief contain "[A] statement of the status of *all the claims, pending or cancelled, and identifying the claims appealed*. (Emphasis supplied.) Petitioner's brief states that "[C]laims 1-10 are the subject of the appeal. No other claims are pending." Obviously, the second sentence is technically inaccurate, because claims 11-17 are pending, albeit that they are withdrawn from consideration pursuant to 37 CFR 1.142(b), because claims are either pending or they are canceled. Moreover, the point of identifying the claims appealed is to distinguish between which of the pending claims are being appealed. As the pending, but withdrawn, claims are not being appealed, they should be identified in the appeal brief as being withdrawn from consideration under 37 CFR 1.142(b). Petitioner is not entitled to relief on this issue.

Claim Groupings (37 CFR 1.192(c))

The examiner held that the brief was defective because the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief. See paper No. 21, dated January 5, 2004, item 6a.

Petitioner's statement in at the top of page 5 of the appeal brief satisfies requirement in 37 CFR 1.192(c) that the brief contain a statement that one or claims do not stand or fall together. All that is required by the regulation of an appellant who does not wish the BPAI to select a single claim from a group of two or more claims to which a given ground of rejection applies and decide the appeal as to all claims to which that ground of rejection applies based upon that selected claim alone is to state that the claims of that group do not stand or fall together. Clearly, stating that "[F]or each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together" is a statement that the claims in a group of claims subject to a given rejection do not stand or fall together where the claims in the group are argued separately. Therefore, the examiner's holding in item 6a of paper No. 21 is clearly erroneous and will be withdrawn.

The examiner further held that the brief was defective because the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief. See paper No. 21, item 6b.

37 CFR 1.192(c) requires that in addition to the statement that claims in a group of claims do not stand or fall together, that an appellant provide in the argument section of the brief (37 CFR 1.192(c)(8)) an explanation of why the some or all of the claims of the group are believed to be separately patentable.

A review of pages 9-15 in the arguments section of the appeal brief fails to show a single instance in which any claim of any claim group is argued as being *separately* patentable from any other claim of that claim group. Petitioner has, for each ground of rejection over the prior art, identified one or two elements that are lacking in the applied prior art and argued patentability based thereon. With respect to claim group of claims 1-10 that is rejected as anticipated by Neville and Dixon (references actually applied in the alternative in the final rejection), petitioner argued only the diverter structure, an element found in independent claims 1 and 8, and therefore, in every claim in the grouping. With respect to the claim group of claims of claims 1-6 and 8-10 that is rejected for anticipation of claims 1-6 and 8-10 over Watson, petitioner identified the diverter and the drinking spout as elements alleged to be lacking in the reference. Both independent claims 1 and 8 include the diverter, while claim 6, dependent on claim 1 and independent claim 8 include the spout (as do claims 9 and 10 dependent thereon). It is simply not clear that petitioner has argued that claim 6 should be patentable even if claim 1 is not, or that claims 9 and 10 should be patentable apart from claim 8. Therefore, petitioner has not presented any explanation of why any claim or claims in this grouping should be independently patentable over any given claim which the BPAI might select, or any identification of which claim or claims are regarded as being separately patentable. With respect to the rejection of claims 4, 5, 9 and 10 for obviousness over Dixon or Neville taken with Rosen, petitioner argues the lack of a fluid diverter in the first two references and the inapplicability of the Rosen reference. Again, no claim in this group is identified as standing apart from

any other claim in the group.

A review of the claim group in which claims 3 and 8-10 are rejected under 35 USC § 112, first paragraph, shows that no claim from that group is argued as standing or falling separately from any other claim in that group.

In summary, the brief clearly fails to argue that any specific claim in any of the claim groups (the group of claims to which a given rejection is applied) does not stand or fall with any of the other claims in that claim group). In fact, no specific claim is identified as not standing or falling with other claims in the same claim group. Therefore, the examiner's holding that the brief is defective because it contains the statement required by 37 CFR 1.192(c)(7), but does not present arguments in support of that statement is correct.

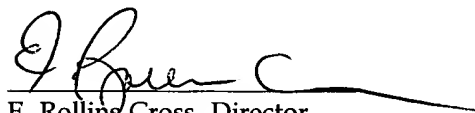
Summary of Relief Granted

In summary:

1. The petition is granted to the extent that the examiner's holding that the brief is defective because it contains material that may arguably be petitionable is clearly erroneous and will be withdrawn.
2. The petition is granted to the extent that the appeal brief is not defective for failing to make a statement on the issue of whether an appealed claim does not stand or fall with other appealed claims, and the objection set forth in paragraph 6a of paper No. 21 is hereby withdrawn.
3. No relief is granted with respect to the examiner's holding that the appeal brief fails to comply with 37 CFR 1.192(c)(3). The examiner's holding is correct because the brief does not mention pending claims 11-16.
4. No relief is granted with respect to the examiner's holding that the appeal brief is defective under 37 CFR 1.192(c)(7) for failing to specifically argue that at least one claim does not stand or fall with the other appealed claims after having stated that the claims do not stand or fall together. See paper No. 21, item 6b.

Petitioner should file a substitute appeal brief which complies with 37 CFR 1.192(c)(3) and 1.192(c)(7). Petitioner is reminded that period for filing the substitute brief continues to run as set in paper No. 21, dated January 5, 2004. See 37 CFR 1.181(f). The application is being forwarded to the Head Supervisory Applications Examiner to refund the \$130.00 petition fee to Deposit Account No. 50-2346.

PETITION GRANTED-IN-PART



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